

REMARKS

INTRODUCTION

In accordance with the foregoing, no claims have been amended. Claims 42 and 43 are pending and under consideration.

CLAIM REJECTIONS

Claims 42 and 43 were rejected under 35 USC 103(a) as being unpatentable over Tsukamoto et al. (US 2002/0048033) (hereinafter "Tsukamoto") in view of the Applicants Admitted Prior Art (hereinafter "AAPA") and further in view of Kanno (US 6,252,609) (hereinafter "Kanno") and Okubo (S 2003/0058471) (hereinafter "Okubo").

Claims 42 and 43

Claim 42 recites: "...if the execution file in the portable storage unit is not executable, the processor displays a message via operation panel unit a message that the execution file in the portable storage unit cannot be executed..."

As noted in the Office Action, the primary reference Tsukamoto nor the other relied upon references Kanno and the AAPA do not discuss displaying, via an operation panel unit, messages. Instead the Office Action relies on the newly-relied upon Okubo to show this feature of claim 42 and specifically relies on paragraphs [0133] – [0135] of Okubo.

In Okubo, when the individual image processing program found in the data storing medium is determined as not performable, the program reader 31a does not perform the program retrieval and the NG notifying unit 124 sends to the PC 21 a notification indicating that the individual image processing program found in the data storing medium is not performable on the MFP 300 so that the PC 21 indicates the same to the user. The function enhancement operation then ends. Okubo, paragraph [0133].

Further in Okubo, as shown in the flowchart of Figure 17 of Okubo, when the individual image processing program candidates from a data storing medium are determined as not operable, the process proceeds to Step S29 in which the NG notifying unit 124 sends to the PC 21 a notification indicating that the individual image processing program candidates are determined as not operable. Thereby, the PC 21 subsequently indicates the same to the user. Next, the procedure ends without performing the program retrieval of the individual image processing program candidates from the data storing medium. Okubo, paragraph [0135].

As is clearly shown above, Okubo discuss a MFP (multifunction-peripheral) apparatus 300 including a NG notifying unit 124. In Okubo, the NG notifying unit 124 returns a notification indicating that an individual image processing program candidate is determined as not good to the PC 21 – the PC 21 being outside of the MFP apparatus 300. In contrast to Okubo, claim 42 recites that the processor displays a message via operation panel unit a message that the execution file in the portable storage unit cannot be executed. In other words, Okubo does not teach or suggest a feature that would lead a person of ordinary skill in the art to modify Tsukamoto or the other relied upon references to display a message via operation panel unit of the image forming apparatus a message that the execution file in the portable storage unit cannot be executed.

Claim 43 recites: "...wherein if the execution file in the portable storage unit is not executable, the processor displays a message via operation panel unit a message that the execution file in the portable storage unit cannot be executed..."

Claim 43 is believed to be allowable for similar reasons as claim 42.

Accordingly, it is respectfully submitted that claims 42 and 43 patentably distinguish over Tsukamoto, the AAPA, Kanno and Okubo.

This technical feature of claims 42 and 43 solves the problem in the conventional art where communication with an external apparatus having a new interface that is not installed in the printer cannot be performed.

The technical problem addressed and solved in the present application as recited in claim 42 and 43 is particularly relevant to Okubo. It is well settled before both the Federal Circuit and the Board of Patent Appeals and Interferences that in determining obviousness, the discovery of the problem is also to be considered. Thus, U.S. patent law permits the patentability of inventions that appear to represent a minor advance over the prior art. For example, see *In re Zurko*, 42 USPQ2d 1476, 1479 (Fed. Cir. 1997) ([A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.") In the present case, if communication with an external apparatus having a new interface that is not installed in the printer cannot be performed, the method and apparatus for image processing of Okubo would not be effective in displaying on the PC 21 a notification indicating that the individual image processing program found in the data storing medium is not performable on the MFP 300.

Withdrawal of the foregoing rejections is requested.

CONCLUSION

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Gregory W. Harper
Gregory W. Harper
Registration No. 55,248

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501